



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant: Izumi HARADA

Title: SETTLEMENT METHOD IN DEAL OF GOODS OR SERVICE

Serial No.: 09/850,134

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Art Unit: 2171

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**INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR §1.56 and 37 CFR §1.97**

Commissioner for Patents
Washington, D.C. 20231

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Sir:

Submitted herewith on Form PTO SB/08 is a listing of documents known to Applicant in order to comply with Applicant's duty of disclosure pursuant to 37 CFR 1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR 1.97 and 1.98.

The submission of any documents herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a prima facie prior art reference against the claims of the present application.

TIMING OF THE DISCLOSURE

The instant Information Disclosure Statement is believed to be filed in accordance with 37 C.F.R. 1.97(b), prior to the mailing date of a first Office Action on the merits (first scenario). If that is not the case, such as in a second scenario in which a first Office Action on the merits has been mailed before the filing of the instant Information Disclosure Statement, then either a certification or fee is required, and a certification is provided below. If neither of the first or second scenarios is the case, such as if a final Office Action or a notice of allowance has been mailed by the PTO (third scenario), then both a certification and fee are required, and in that case a certification is provided below and also the PTO is authorized to obtain the necessary fee to have the instant IDS considered, from Foley & Lardner Deposit Account #19-0741.

CERTIFICATION

The undersigned hereby certifies in accordance with 37 C.F.R. §1.97(e)(1) that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to the filing of this Statement.

RELEVANCE OF EACH DOCUMENT

A translation of a portion of a China Office Action that issued January 10, 2003 with respect to a counterpart Japanese patent application is provided below.

"1. Claim 1 claims a settlement method in a deal of the goods or the service. The reference 1(WO 9613814 A1) discloses a payment and settlement system using the mobile telephone in a deal of the goods or the service. The following contents are disclosed wherein (see paragraph 3 on page 3, paragraph 2 on page 4, over page 5 of description of the reference 1 and its abstract and Fig. 4). More specifically, the following steps features are disclosed from the reference 1, they include (1) an identification information of the purchaser identity for identifying a purchaser by a mobile terminal; (2) a purchaser reading in a deal sum and said seller accounts by said mobile terminal (said deal sum and seller accounts are respectively the corresponding specific concepts of

said deal information and said seller identification information of the present invention); (3) a purchaser reading in a cipher or access code by said mobile terminal (said cipher or access code are respectively the corresponding specific concepts of said authentication information of said purchaser of the present invention); (4) transmitting said identification information of the buyer identity, said deal sum and said seller accounts, said cipher or access code to a computer center (which is equivalent with settlement computer of the present invention) by said mobile terminal; (5) back-checking a purchaser's account by said computer center (which is equivalent with the process of the authenticating said purchaser of the present invention); and (6) carrying out said settlement by said computer center based on the above information.

It is obvious that the technical features of the technical solution claimed by Claim 1 of the application are disclosed by the reference 1, except the second step wherein. However, it is not difficult that the technical feature of the step 2 is deduced from the technical solution of the reference 1. In fact, it is necessary to prepare the above information, in order to reading in a deal sum and said seller accounts by said mobile terminal (said deal information and said seller identification information).

In the other hand, even though a subject of the present invention relates to a method while that of the reference 1 is a system, all of steps for carrying out said method defined by Claim 1 of the present invention are included in the system disclosed by the reference 1. Therefore, all of the technical features contained in Claim 1 are disclosed by the reference 1. Furthermore, the technical solutions of both the reference 1 and the Claim 1 of the application belong to the same technical field and same technical effects are produced from them. So, the technical solution claimed by Claim 1 is not in conformity with the provision relating to the novelty of the 2nd paragraph of Article 22 of CPL.

The following is a quotation of the 2nd paragraph of Article 22 of the Patent Law of the People's Republic of China:

Novelty means that, before the date of filing, no identical invention or utility model has been publicly disclosed in publications in the country or abroad or has been publicly used or made known to the public by any other means in the country, nor has any other person filed previously with the Patent Administration Department Under the State Council an application

which described the identical invention or utility model and was published after the said date of filing.

2. The additive technical features in the characterizing portion of Claim 2 are not clear, so it is not in conformity with the provision of the 1st paragraph of Rule 20 of the Implementing Regulations of CPL. The technical meaning of the sentence "inputting a transmission enable or disable signal by said mobile terminal, wherein only when said transmission enable or disable signal is positive, said mobile terminal transmits said seller identification information, said purchaser identification information, said deal information and said authentication information to said settlement computer" is not clear. That is, what steps are included wherein. More specifically, what is the manner for ensuring and determining the inputted signal is a positive signal or a negative signal, since "inputting a transmission enable or disable signal by said mobile terminal". Moreover, it is not logistic that each of said seller identification information, said purchaser identification information, said deal information and said authentication information are transmitted to said settlement computer by said mobile terminal when said transmission enable or disable signal is positive. The applicant should explain or amend it.

The following is a quotation of the 1st paragraph of Rule 20 of the Implementing Regulations of the Patent Law of the People's Republic of China:

The claims shall define clearly and concisely the matter for which protection is sought in terms of the technical features of the invention or utility model.

It should be noted, the above unclear regarding to Claim 2 is only in the form other than it is not in the substantiality. In fact, the examiner's understanding for the above contents is that it will be determined whether said information be transmitted to settlement computer by means of inputting a relevant signal by said mobile terminal. The following examination opinions are arisen by the examiner based on this understanding.

The additive technical features contained in Claim 2 relate to some step features. They include displaying said deal information by said mobile terminal, and determining whether said mobile terminal transmits said seller identification information, said purchaser identification information, said deal information and said authentication information to said settlement computer. However, these contents are disclosed by the reference 2 (WO 9847116 A1) (see from line 14 of page 16 to line 3 of page 17 in reference 2).

In the situation that Claim 1 referred to Claim 2 lacks the novelty, the technical solution claimed by Claim 2 has not prominent substantive feature and does not represent a notable progress relatively to the combining of references 1 and 2. So, Claim 2 is not in conformity with the provision relating to the inventiveness of the 3rd paragraph of Article 22 of CPL.

The following is a quotation of the 3rd paragraph of Article 22 of the Patent Law of the People's Republic of China:

Inventiveness means that, as compared with the technology existing before the date of filing, the invention has prominent substantive feature and represents a notable progress and that the utility model has substantive features and represents progress.

3. The additive technical feature contained in Claim 3 includes that said mobile terminal displays also said seller identification information. However, this content is disclosed by the reference 2 (see lines 14-24 of page 16 in reference 2). In the situation that Claim 2 referred to Claim 3 lacks the inventiveness, the technical solution of Claim 3 has not prominent substantive feature and does not represent a notable progress relatively to the combining of the references 1 and 2. So, Claim 3 is not in conformity with the provision relating to the inventiveness of the 3rd paragraph of Article 22 of CPL.

4. The additive technical features contained in the characterizing portion of Claim 4 are not clear, so Claim 4 is not in conformity with the provision of the 1st paragraph of Rule 20 of the Implementing Regulations of CPL. In fact, it is ambivalent each other between the step 2 in Claim 4 and the contents contained by Claim 2 which is referred by Claim 4. More specifically, it is required that said seller identification information is directly transmitted by said mobile terminal according to the step 2 in Claim 4 while said information will be transmitted after said transmission enable or disable signal inputted from the mobile terminal is undergone the determination.

5. The difference between the additive technical features contained in the characterizing portion of Claim 5 and the technical solution in Claim 2 referred by Claim 5 are that the seller miscellaneous information is added in Claim 5. However, it is easily considered by a person skilled in the relevant field of the technology that it is necessary to add said seller miscellaneous information, when the seller can not be determined by the

purchaser merely based on the seller identification information. In addition, the methods for preparing said seller miscellaneous information, reading-in and displaying said information by said mobile terminal are the general knowledge. In the situation that Claim 2 referred to Claim 5 lacks the inventiveness, the technical solution of Claim 5 has not prominent substantive feature and does not represent a notable progress. So, Claim 5 is not in conformity with the provision relating to the inventiveness of the 3rd paragraph of Article 22 of CPL.

6. The additive technical features contained in the characterizing portion of Claim 6 relates to the step of storing said information displayed by said mobile terminal. This is only a general function for said mobile terminal. It is merely a general knowledge in the relevant field of the technology. In the situation that Claim 2 referred to Claim 6 lacks the inventiveness, the technical solution of Claim 6 has not prominent substantive feature and does not represent a notable progress. So, Claim 6 is not in conformity with the provision relating to the inventiveness of the 3rd paragraph of Article 22 of CPL.

7. Moreover, since Claims 3-6 refer respectively to Claim 2, in the situation which the claimed scope of Claim 2 is not clear, Claims 3-6 are unclear. Claims 3-6 are not in conformity with the provision of the 1st paragraph of Rule 20 of the Implementing Regulations of CPL.

8. The additive technical features contained in the characterizing portion of Claims 7 and 8 are not supported by the description, so they are not in conformity with the provision of the 4th paragraph of Article 26 of CPL. There are not provided any corresponding embodiment disclosures or any hints in other portions of the description, even said additive technical features contained in the characterizing portion of Claims 7 and 8 are disclosed in summary portion of the description with the same contents.

9. The additive step feature contained in the characterizing portion of Claims 9 and 16 are disclosed by the reference 2 (see on page 18, lines 25-28). Further, said steps play the same role in the present invention as that of the reference 2. It is found that a teaching is provided from the reference 2, which the above additive step features may be used to the technical solutions of Claims 9 and 16 to overcome the technical problems written in the description of the application. That is, for a person skilled in the relevant field of the technology, it is obvious that the technical solutions of Claims 9 and 16 may be obtained by combining the

contents of the reference 2 based on the reference 1. Furthermore, any notable technical effects are not produced by the technical solutions of Claims 9 and 16. In the situation that Claim 1 referred to Claims 9 and 16 lacks the novelty, the technical solutions claimed by Claims 9 and 16 have not prominent substantive feature and do not represent a notable progress relatively to the combining of references 1 and 2. So Claims 9 and 16 lack inventiveness. Claims 9 and 16 are not in conformity with the provision relating to of the 3rd paragraph of Article 22 of CPL.

10. Claims 10, 11, 14 and 15 further define the technical solution of Claim 9, respectively. The additive technical features contained in these claims (transmitting either said deal information or said purchaser identification information to said apparatus, displaying or printing said received information or storing said received information by said apparatus) may be arbitrarily selected by a person skilled in the relevant field of the technology. In fact, it is easily done that any of said steps is added to the technical solution of Claim 9 for a person skilled in the relevant field of the technology, because they are the general knowledge. In the situation that Claim 9 referred to these claims lacks the inventiveness, the technical solutions of Claims 10, 11, 14 and 15 have not prominent substantive feature and do not represent a notable progress. So, Claims 10, 11, 14 and 15 are not in conformity with the provision relating to the inventiveness of the 3rd paragraph of Article 22 of CPL.

11. The first additive step feature contained in the characterizing portion of Claim 12 is disclosed by the reference 2 (see paragraph 4 on page 11). The second step feature is the same as that of the additive features contained in the characterizing portion of Claims 10 and 11. All of these technical features are the general knowledge in the relevant field of the technology. In the situation that Claim 9 referred to Claim 12 lacks the inventiveness, the technical solution of Claim 12 has not prominent substantive feature and does not represent a notable progress. So, Claim 12 is not in conformity with the provision relating to the inventiveness of the 3rd paragraph of Article 22 of CPL.

12. The technical solution defined by Claim 13 is not clear, so it is not in conformity with the provision of the 1st paragraph of Rule 20 of the Implementing Regulations of CPL. More specifically, the phrase "making a predetermined operation" has an unclear technical meaning. According to the examiner's understanding, the said deal is completed, that is the goods or a service will be provided to the purchaser, after the said received settlement completion information and deal information are

received from the apparatus at the seller. However, this process is the general knowledge in the relevant field of the technology. Because the settlement method related to the present invention serves to provide a convenience for completing said deal, it will be allowed that the above step which is a final step for completing said deal can not be lacked. In the situation that Claim 10 referred to Claim 13 lacks the inventiveness, the technical solution of Claim 13 has not prominent substantive feature and does not represent a notable progress. So, Claim 13 is not in conformity with the provision relating to the inventiveness of the 3rd paragraph of Article 22 of CPL.

13. Claims 17, 18, 21 and 22 further define the technical solution of Claim 16, respectively. The additive technical features contained in these claims (transmitting either said deal information or said seller identification information to said mobile terminal, displaying said received information or storing said received information by said mobile terminal) may be arbitrarily selected by a person skilled in the relevant field of the technology. In fact, it is easily done that any of said steps is added to the technical solution of Claim 16 for a person skilled in the relevant field of the technology, because they are the general knowledge. In the situation that Claim 16 referred to these claims lacks the inventiveness, the technical solutions of Claims 17, 18, 21 and 22 have not prominent substantive feature and do not represent a notable progress. So, Claims 17, 18, 21 and 22 are not in conformity with the provision relating to the inventiveness of the 3rd paragraph of Article 22 of CPL.

14. The first additive step feature contained in the characterizing portion of Claim 19 is disclosed by the reference 2 (see from line 28 of page 11 to line 6 of page 12). The second step feature is the same as that of the additive features contained in the characterizing portion of Claims 17 and 18. All of these technical features are the general knowledge in the relevant field of the technology. In the situation that Claim 16 referred to Claim 19 lacks the inventiveness, the technical solution of Claim 19 has not prominent substantive feature and does not represent a notable progress. So, Claim 19 is not in conformity with the provision relating to the inventiveness of the 3rd paragraph of Article 22 of CPL.

15. Claim 20 refers directly to Claim 16 and indirectly to Claim 1, in which the first, second and third step features contained in its characterizing portion merely add the content of "said seller miscellaneous information" into corresponding steps. Therefore it has the same comment as that of Claim 5. In addition,

the comment for the fourth step is the same as that of Claims 18 and 19. In the other hand, any notable technical effects are not produced through combining the said steps 1-4. In the situation that Claim 16 referred to Claim 20 lacks the inventiveness, the technical solution of Claim 20 has not prominent substantive feature and does not represent a notable progress. So, Claim 20 is not in conformity with the provision relating to the inventiveness of the 3rd paragraph of Article 22 of CPL.

16. The additive technical features contained respectively by Claims 23-33 further define either the contents relating to said purchaser identification information, said purchaser miscellaneous information, said deal information, said seller identification information, said seller miscellaneous information, and said authentication information or their representative forms. These additive step features may be selected by a person skilled in the relevant field of the technology according to his or her requirement. It is merely the general knowledge in the relevant field of the technology. Therefore, in the situation that Claim 1 directly referred to these claims lacks the novelty or Claim 5 indirectly referred to these claims lacks the inventiveness, the technical solution of Claims 23-33 have not prominent substantive feature and do not represent a notable progress. So, Claims 23-33 are not in conformity with the provision relating to the inventiveness of the 3rd paragraph of Article 22 of CPL.

17. Claims 30 and 31 refer respectively the Claim 5. In the situation that Claim 5 is not clear, Claims 30 and 31 are also not clear, so they are not in conformity with the provision of the 1st paragraph of Rule 20 of the Implementing Regulations of CPL.

18. Claim 34 refers the Claim 4. In the situation that Claim 4 is not clear, Claim 34 is also not clear, so it is not in conformity with the provision of the 1st paragraph of Rule 20 of the Implementing Regulations of CPL.

19. Claim 35 claims a mobile terminal. A similar mobile terminal is disclosed in a real time tele-payment system of the reference 1. The following technical features are disclosed wherein (see paragraph 3 of page 3, paragraph 2 of page 4, over page 5 of description of the reference 1 and its abstract and Fig. 4). More specifically, the following features are disclosed in the reference 1, they include (1) storing said purchaser identity identification information for identifying said purchaser by a mobile terminal; (2) reading in a deal sum and said seller accounts by said mobile terminal (said deal sum and seller accounts are respectively the corresponding specific concepts of said deal information and said

seller identification information in the present invention); (3) reading in a cipher or access code by said mobile terminal (said cipher or access code are respectively the corresponding specific concepts of said authentication information of said purchaser in the present invention); (4) transmitting said identification information of the purchaser identity, said deal sum and said seller accounts, said cipher or access code to a computer center (which is equivalent with settlement computer of the present invention) by said mobile terminal.

It is obvious that all of the technical features of Claim 35 of the application are disclosed by the reference 1. Furthermore, the technical solutions of both the reference 1 and the Claim 35 of the application belong to the same technical field and same technical effects are produced from them. So, the technical solution claimed by Claim 35 is not in conformity with the provision relating to the novelty of the 2nd paragraph of Article 22 of CPL.

20. The additive technical feature in the characterizing portion of Claim 36 is also disclosed by the reference 1 (see the contents in paragraph 2 of page 5). Thus, in the situation that Claim 35 referred by Claim 36 lacks the novelty, the technical solution of Claim 36 is not in conformity with the provision relating to the novelty of the 2nd paragraph of Article 22 of CPL.

21. Claim 37 claims a settlement computer. A similar settlement computer is disclosed in a real time tele-payment system of the reference 1. The following technical features regarding to a settlement computer are disclosed wherein (see paragraph 3 of page 3, paragraph 2 of page 4, over page 5 of description of the reference 1 and its abstract and Fig. 4). More specifically, the following features regarding to a settlement computer are disclosed by the reference 1, they include: (1) receiving various information for the settlement from said mobile terminal; (2) back-checking a purchaser's account (which is equivalent with the process of the authenticating said purchaser in the present invention); (3) carrying out the settlement used the above information.

It is obvious that all of the technical features of Claim 37 of the application are disclosed by the reference 1. Furthermore, the technical solutions of both the reference 1 and the Claim 37 of the application belong to the same technical field and same technical effects are produced from them. So, the technical solution claimed by Claim 37 is not in conformity with the provision relating to the novelty of the 2nd paragraph of Article 22 of CPL.

22. The additive technical features contained in the characterizing portion of Claims 38 and 42 are disclosed by the reference 2 (see on page 18, lines 25-28). Further, said technical features play the same role in the present invention as that of the reference 2. It is found that a teaching is provided by the reference 2, which the above additive features may be used to the technical solutions of Claim 37 to overcome the technical problems written in the description of the application. That is, for a person skilled in the relevant field of the technology, it is obvious that the technical solutions of Claims 38 and 42 may be obtained by combining the contents of the reference 2 based on the reference 1. Furthermore, any notable technical effects are not produced by the technical solutions of Claims 38 and 42. In the situation that Claim 37 referred by Claims 38 and 42 lacks the novelty, the technical solutions claimed by Claims 38 and 42 have not prominent substantive feature and do not represent a notable progress relatively to the combining of references 1 and 2. So Claims 38 and 42 lack inventiveness. Claims 38 and 42 are not in conformity with the provision relating to of the 3rd paragraph of Article 22 of CPL.

23. The additive technical features contained in the characterizing portion of Claims 39, 40, 43 and 44 are the general knowledge. A person skilled in the relevant field of the technology can transmit any requirement information to said apparatus using said settlement computer. In a situation that Claims 38 and 42 referred respectively by Claims 39, 40 and 43, 44 lack the inventiveness, the technical solutions of Claims 39, 40, 43 and 44 have not prominent substantive feature and do not represent a notable progress relatively to a combining of the references 1 and 2 and the general knowledge. So Claims 38 and 42 lack inventiveness. Claims 38 and 42 are not in conformity with the provision relating to of the 3rd paragraph of Article 22 of CPL.

24. One of the additive technical features contained in the characterizing portion of Claim 41 is disclosed by the reference 2 (see paragraph 4 of page 11). Furthermore, the feature of transmitting said purchaser miscellaneous information to said apparatus is the same of the additive technical features contained in the characterizing portion of Claims 39 and 40, that is they belong the general knowledge in the relevant field of the technology. In a situation that Claim 38 referred by Claim 41 lacks the novelty, the technical solution of Claim 41 has not prominent substantive feature and does not represent a notable progress relatively to a combining of the references 1 and 2 and the general knowledge. So Claim 41 lacks inventiveness. Claim 41 are not in

conformity with the provision relating to of the 3rd paragraph of Article 22 of CPL."

Applicants' statements regarding the China Office Action are based on a partial translation that Applicants' representative obtained. These statements should in no way be considered as an agreement by Applicant with, or an admission of, what is asserted in the China Office Action.

Applicant respectfully request that the listed document be considered by the Examiner and formally be made of record in the present application and that an initialed copy of Form PTO SB/08 be returned in accordance with MPEP §609.

Respectfully submitted,

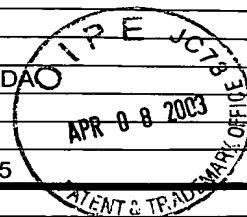
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Sheet	1	of	1		



U.S. PATENT DOCUMENTS						
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